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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CALAMITA, HEATHER

ART UNIT

PAPER NUMBER

1637

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/031,910

Applicant(s)

NYGREN ET AL.

Examiner

Heather G. Calamita, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 14-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☒ Claim(s) 4, 10 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/29/02; 5/19/03
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Amendment Entry

1. The preliminary amendment filed January 17, 2002, has been entered. The specification, claims 6, 7, 9, 11, 12, 13 have been amended. The abstract is in conformance with U.S. practice.

Information Disclosure

2. The information disclosure statement filed May 19, 2003 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. The citations on form 1449 that have been lined through have not been considered because these publications are not present in the file.

Claim Objections

2. Claims 4, 10, 11 and 12 are objected to because of the following informalities: The word immobilized is misspelled in these claims. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The preamble of claim 1 recites a method for the selection of one or more desired polypeptides.

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However, the claim fails to set forth any active method steps involved in the process and it is therefore unclear what method or process applicant is intending to encompass.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Taussig (WO 98/54312, 12/3/1998).

Taussig teaches (claim 1) a method for the selection of one or more desired

polypeptides comprising: (a) cell free expression of nucleic acid molecules immobilized on a solid support system to produce polypeptides, the solid support carrying means for biospecific interaction with at least the desired polypeptide or a molecule attached thereto (see abstract); (b) separation of the solid support carrying both the desired polypeptide and the nucleic acid encoding it; and optionally recovery of the said nucleic acid and/or said desired polypeptide (see abstract). With regard to claim 2, Taussig teaches the expressed polypeptides are fusion proteins (see p. 26, Example 13). With regard to claim 3, Taussig teaches each fusion protein comprise a variable portion and a common portion (see p. 26, Example 13). With regard to claim 4, Taussig teaches the common portion comprises an affinity fusion partner whose cognate binding partner is immobilized on the solid support (see p. 26, Example 13). With regard to claim 5, Taussig teaches the common portion comprises a reporter protein moiety (see p. 1 second paragraph). With regard to claim 6, Taussig teaches the variable portion is a member of a polypeptide library (see p. 26, Example 14). With regard to claim 7, Taussig teaches steps (a) and (b) are performed iteratively for more than one cycle (see p. 24, Example 11). With regard to claim 8, Taussig

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teaches, steps (a) and (b) are performed between 2 and times (see p. 24, Example 11). With regard to claim 9, Taussig teaches the solid support system is particulate (see the abstract Figure and p. 26, Example 13). With regard to claim 10, Taussig teaches immobilized on each solid support particle is a nucleic acid molecule and said means for biospecific interaction with at least the desired polypeptide or a molecule attached thereto (see the abstract Figure). With regard to claim 11, Taussig teaches the immobilized means for biospecific interaction is a target molecule for the desired polypeptide (see the abstract Figure and p. 26, Example 13). With regard to claim 12, Taussig teaches the immobilized means for biospecific interaction is a cognate binding partner for an affinity binding partner which forms a fusion protein with the desired polypeptide (see p. 26, Example 13 and 14). With regard to claim 13, Taussig teaches a nucleic acid molecule or polypeptide when selected according to the method of claim 1 (see p. 26, Example 13).

Summary

5. No claims allowed.

Conclusion


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heather G. Calamita whose telephone number is 571.272.2876 and whose e-mail address is heather.calamita@uspto.gov. However, the office cannot guarantee security through the e-mail system nor should official papers be transmitted through this route. The examiner can normally be reached on weekdays 7:00 A.M. - 5:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571.272.0782. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

hgc


KENNETH R. HORLICK, PH.D
PRIMARY EXAMINER
12/2/04